

31. (Amended) The insert precursor of claim 28, wherein the length of at least one of said portions is less than a circumference of the human cornea.

32. (Amended) The insert precursor of claim 28, wherein the length of at least one of said portions approximates a circumference of the human cornea.

II. REMARKS

Claims 23, 24, 28, and 30-37 are pending in the application. Claims 23, 24, 28 and 30-37 were examined and stand variously rejected under 35 U.S.C. §§ 112, second paragraph, 102(b) and 102 (e). The Examiner has also objected to the absence of an abstract of the disclosure as required by 37 C.F.R. § 1.72 (b).

Claim 28 has been amended to correct an error in syntax, clarifying that at least one of the two or more adjoining portions is constructed to effect correction of a refractive disorder of the eye after implantation. Claims 31 and 32 have been amended in order to provide "the circumference" with proper antecedent basis. Support for the amendments can be found in the claims and specification as originally filed.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made." Also attached hereto is the abstract of the disclosure on a separate page.

These amendments have been made to advance prosecution or place the claims in condition for allowance or appeal. They are not intended to be a dedication to the public of the claims as previously presented. The amended claims were not presented earlier because Applicant maintains that the prior claims presented patentable subject matter. No new matter has been added as a result of these amendments and entry thereof is respectfully requested.

Claims 23, 24, 28, and 30-37 are presently under examination. In view of the preceding amendments and the following remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding objections and rejections.

Abstract Requirement

The Examiner objected to the lack of an abstract of the disclosure as required by 37 C.F.R. § 1.72 (b). The application has been amended to incorporate the abstract on a separate sheet as required. In view of this amendment, reconsideration and withdrawal of this objection is respectfully requested.

35 U.S.C. § 112, Second Paragraph

Claims 28 and 30 to 34 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter, which Applicant regards as the invention. The amendments of claims 28, 31 and 32 have been made in a sincere effort to overcome the rejections. In view of these amendments, reconsideration and withdrawal of the rejections is respectfully requested.

35 U.S.C. § 102 (b)

Claims 35 to 37 stand rejected under 35 U.S.C. § 102 (b) as allegedly anticipated by Simpson et al. (U.S. Patent No. 5,076,684). The Office maintained that Simpson discloses an implant comprising multiple sections having substantially different cross-sections. The Office further maintained that the modulus of elasticity being less than 500 psi is inherent because of the materials typically used for artificial corneas and intralamellar implants.

Applicant respectfully traverses.

Claim 35 recites an implant comprising multiple sections each adapted for implantation within the cornea of a human eye, said sections having substantially different cross-sections and having a modulus of elasticity less than about 3.5 kpsi, at least one of said sections being adapted to effect correction of a refractive disorder of the eye.

In contrast, Simpson et al. describes a *lens* having a plurality of diffractive zones including a circular central zone and a plurality of concentric annular zones (emphasis added). *See*

specification at column 2, lines 41-42 and Figures 1 and 4. Simpson et al. does not disclose the present invention wherein the implant is comprised of multiple sections, each section having substantially different cross-sections.

Thus, claim 35 and claims 36 and 37, which depend from claim 35, are allowable over Simpson et al. and Applicant respectfully requests withdrawal of the rejection.

35 U.S.C. §102 (e)

Claims 23, 24, 28 and 30 to 37 stand rejected under 35 U.S.C. §102 (e) as allegedly anticipated by Silvestrini et al. (U.S. Patent No. 5,300,118). The Office directs attention to Figures 11A, 11B and to column 10, lines 14 to 27.

Applicant respectfully traverses.

Claim 23 recites an implant comprising a plurality of sections constructed to effect correction of a refractive disorder. In contrast, Figures 11A and 11B of the '118 patent disclosed two rings which are intermeshed, wherein the two rings in combination provide varying thickness. In other words, the implant of the '118 patent comprises two rings (111) and (112) as shown in Figures 11A and 11B. Thus, the Silvestrini reference clearly does not anticipate claim 23 and Applicant maintains that claim 23 and claim 24, which depends from claim 23, are allowable over the Silvestrini reference.

Further, independent claim 28 recites an insert precursor comprising a member including a body comprising at least two portions each constructed to effect correction of a refractive disorder of the eye after implantation. In contrast, the combination of the two rings of the Silvestrini reference, not each individual ring, effect correction of a refractive disorder.

Further, as noted above, claim 35 recites an implant comprising multiple sections constructed to effect correction of a refractive disorder. Again, it is the combination of the two rings of the Silvestrini reference, not each individual ring, which may effect correction of a refractive disorder. Clearly, the Silvestrini reference does not anticipate independent claim 35 nor 36 or 37, dependent from claim 35.

In view of the preceding remarks, Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 102 (e).

III CONCLUSION

If a telephone interview would advance prosecution of the subject application, the Examiner is invited to telephone the undersigned at the number provided below.

In the unlikely event that the transmittal letter is separated from this document and/or the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 50-1189, referencing billing reference 23915-7319. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Date: October 15, 2001

By: 

Antoinette F. Konski

Reg. No. 34,202

McCutchen, Doyle, Brown & Enersen, LLP
Three Embarcadero Center, Suite 1800
San Francisco, California 94111
Telephone: (650) 849-4950
Telefax: (650) 849-4800

VERSION WITH MARKINGS TO SHOW CHANGES MADE

24. (Amended) The device of claim 23 wherein the cross-section areas of said plurality of adjoining sections are substantially different from each other.

28. (Amended) An insert precursor suitable for introduction into a human cornea, said insert precursor comprising a physiologically compatible member having two ends and an elongated body extending therebetween, the body comprising at least two adjoining portions at least one of which is constructed to effect correction of a refractive disorder of the eye after implantation, the cross-sectional area of said member changing substantially stepwise from one portion to the next along the body.

31. (Amended) The insert precursor of claim 28, wherein the length of at least one of said portions is less than [the] a circumference of [a] the human cornea.

32. (Amended) The insert precursor of claim 28, wherein the length of at least one of said portions approximates [the] a circumference of [a] the human cornea.